

Patent
Attorney Docket No.: 404082

REMARKS

Claims 1-13 are pending in the application. Claim 1 is currently amended.

Claim 1 has been amended to recite that the side members and the cross member are constructed and arranged for concealment when installed under a motorcycle fender, as is shown in the drawings and described in the specification.

Claims 7-9 stand rejected under 35 U.S.C. §103(a) over Kauffman in view of Neal. Kauffman is nonanalogous art and references a car dolly. Applicant's attorney respectfully traverses this rejection. A motorcycle cannot be used to tow a car and so Kauffman would not have been consulted by those skilled in the art when seeking to design an extension piece that is pulled by a motorcycle. Kauffman is not an applicable reference and cannot be used in support of this §103(a) rejection. Without Kauffman the rejection fails.

Even if Kauffman is applicable, there is no motivation in the art to modify Neal by the use of Kauffman's square tubing and front attachment for mounting a socket mechanism. It is not enough that the Kauffman structure can be modified for random substitution into Neal. There must be a motivation to do so. The alleged motivation is to strengthen the tongue. The excess strength that is asserted as motivation may be applicable to the increased load of a nonanalogous car dolly, but super-strength is generally not required in a motorcycle towing device. Light weight is more important and so the alleged motivation is unnecessary, is based on the nonanalogous nature of Kauffman which makes Kauffman irrelevant to the present claim, and

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actually teaches away from what is claimed when the importance of weight is considered as a design criterion.

Claims 1, 2, 4-6 and 13 stand rejected under 35 U.S.C §103(a) as being unpatentable over Alvord in view of Maier. Applicant's attorney respectfully traverses this rejection. Alvord is said to show the side members extending farther than the side members, so Alvord does not meet the claimed element of the cross member extending between the side members at a point of maximum downward extension of the side members. Maier is used to show this feature. The alleged motivation is to provide a smooth rear edge of the mounting to lessen the likelihood of injury due to contact with the hitch and receiver. This cannot be a suitable motivation when the assembly is concealed under a motorcycle fender that itself prevents this type of injury by precluding such access. Alvord pertains to this type of concealed hitch assembly and claim 1 has been amended to recite the construction for concealment. Thus, the asserted motivation cannot exist because the potential injury is prevented by the motorcycle fender in the intended environment of use and, consequently, is not a design consideration.

The recited limitation is not a mere equivalent substitution or equal design choice. Where Alvord presumably opts to increase lateral stability by the downwardly extending tabs interacting by abutment with the fender, it has been found in practice that overall performance is best facilitated by eliminating the tabs to lower the ball for presentation to the trailer tongue. This is a significant distinction and represents a different design philosophy.

Claim 3 stands rejected under 35 U.S. C. §103(a) over Alvord as applied to claim 1 and in further view of McIntosh. McIntosh is used to show a trailer height adjustment mechanism,

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but the overall combination cannot be sustained because there is no motivation to combine for the same reasons that are explained above.

The tubular Maier hitch cannot be mounted for concealability beneath the motorcycle fender, and so use of the Maier hitch would defeat the primary purpose of Alford in providing a concealable hitch assembly. Therefore, there is no suggestion, rather, there is a teaching away.

Claims 8 and 9 stand rejected under 35 U.S. C. §103(a) over Kauffman in view of Lazar. Although these claims have patentable merit on their own, they are at least patentable because they depend from a patentable base claim, as shown by the remarks above.

Applicant's attorney continues to assert and requests reconsideration that Alford is not prior art due to the conception that is shown in provisional application serial number 60/139,064 filed 6/11/99. The Examiner cites MPEP 2138.04 and asserts that the provisional merely proves conception and that a Rule 131 declaration must be provided to show diligence. In our previous response, we cited case law showing that Rule 131 is only one way of meeting the requirement and so now respectfully request the Examiner's direct response to that case law in the emphasized passage below. *In re Costello and McClean*, 219 U.S.P.Q. 389, 391 (Fed. Cir. 1983) states:

Rule 131, however, is only one way of overcoming a reference that is not a statutory bar. An applicant may also overcome a reference by showing that the relevant disclosure is a description of the applicant's own work.⁸ The pertinent inquiry is under 35 U.S.C. §102(e).⁹ Appellants can overcome a reference by showing that they were in possession of their invention prior to the effective date of the reference. "The real issue is whether all the evidence, including the references, truly shows knowledge by another prior to the time appellants made their invention or whether it shows the contrary." [emphasis added; citing *In re Land and Rogers*, 151 U.S.P.Q. 621, 632 (CCPA 1966)].

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The '064 provisional is sufficient to show *knowledge* by Applicant of the presently claimed invention prior to the filing date of Alford, and so antedates Alford which therefore cannot be used as prior art. Therefore, the rejection of claims 1-6 and 13 cannot be sustained by Alford.

Based upon the foregoing discussion, we respectfully submit that claims 1-13 are allowable. Applicant's attorney believes that no additional fees are due, but the Commissioner is authorized to charge any additionally required fees to deposit account 12-0600. Applicant's attorney urges the Examiner to telephone if a conversation could expedite prosecution.

Respectfully Submitted,



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